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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,832	03/13/2000	Jennie Ching	1504P/BC999069	6617

7590

04/26/2005

Sawyer Law Group
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EXAMINER

THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

5

Office Action Summary

Application No.

09/523,832

Applicant(s)

CHING ET AL.

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/13/2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This application has been reassigned to a new Examiner. See Conclusion section below, for new Examiner contact information.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action, received 4/7/2005, is persuasive and, therefore, the finality of that action is withdrawn.
3. Claims 1-20 remain pending.

Priority

4. No claim for priority has been made in this application.
5. The effective filing date for the subject matter defined in the pending claims in this application is 3/13/2000.

Drawings

6. The drawings received on 3/13/2000 are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the logical intermediary positioning of the Internet file server (IFS) residing between the "local traffic system" and the "central site" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-32 of copending Application No. 09/420,802, in view of Allen et al. (U.S. Patent Number 5,892,535), hereinafter referred to as Allen. This is a provisional obviousness-type double patenting rejection. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

9. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09/773,047, in view of Allan et al. (U.S. Patent Number 5,892,535), hereinafter referred to as Allen. This is a provisional obviousness-type double patenting rejection. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

10. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 09/784,865, in view of Allen et al. (U.S. Patent Number 5,892,535), hereinafter referred to as Allen. This is a provisional obviousness-type double patenting rejection. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

11. The claimed invention relates to a central site of a digital media distributor system serving to assemble programming and advertisement according to a schedule, local traffic systems providing scheduling information in regard to programming and transmissions, and file transfer. These features are shared by all the above co-pending applications claimed subject

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matter. The current specification and claims further include the provision for a logically intermediate file server which supports file transfer between the central site and the local traffic machinery. Allen clearly disclosed the use of a low level local media server (202) which functioned to mediate the passage information and traffic between the high level remote media server (222) (central site) and the distribution network interface units (206) (at least one local traffic system). See, inter alia, Column 12, Line 31 through Column 13, Line 20, and Figure 2. Likewise, the remote (or any other) media server was also described as intermediate to off-site storage facilities and the distribution network interfaces in this section, particularly, Column 13, Lines 1-20. The provision for storage of information retrieved from external program sources for storage in the media servers (inter alia, Column 12; Lines 7-19), and the insertion of stored advertisements in the media servers for dissemination of combined programmatic information to end terminals in the distribution network (inter alia, Column 12, Lines 31-54), display bidirectional information flow between network elements, plainly evident from the Allan teachings in the entirety of the document, not only the above cited sections. Also, the routine rearrangement of functional elements within the system, including placement of the functional intermediate server(s) in various devices (i.e., the local and/or remote media servers) provided immense flexibility in implementation readily recognized by one of ordinary skill in the art at the time of invention. In short, the media server(s) receive and store externally originating program data (inter alia, Column 11, Lines 1-5), "splice in" stored local data (inter alia, Column 9, Lines 43-52), and outputs specialized viewable program data (inter alia, Column 8, Line 62 through Column 9, Line 22), utilizing the media server(s) as intermediaries, precisely as claimed. Thus, since Allan specifically disclosed network storage of program data, network storage of

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insertion data, and at least one intermediate device providing bidirectional communication between the media server(s) and the distribution points, the provision for these well known features in the systems as set forth in the claimed systems of all three (3) patented documents, renders the claims obvious over these combined teachings. It would have been obvious to modify any/all of the above patented documented systems with the teachings of Allan, minimally, in order to enhance a digital distribution system (inter alia, Column 10, Lines 4-14), resulting in a "flexible and configurable system for distributing programming to one or more distribution networks by providing [an intermediate] media server". See, inter alia, Column 10, Lines 18-25.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

14. Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Carles (U.S. Patent Number 5,515,098), hereinafter referred to as Carles, in view of Safadi (U.S. Patent Number 6,487,721), hereinafter referred to as Safadi.

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15. Carles disclosed a hierarchical arrangement of head end servers for video distribution of a wide area network. See, Column 8, Lines 54 through Column 9, Line 2, and Figure 5. The system utilized servers inserting content into prerecording programming transmission content. See, *inter alia*, Column 3, Lines 1-40. This stored content included real-time information, e.g., live broadcasts, etc. See, Column 3, Lines 12-13.

16. While Carles disclosed the invention substantially as claimed, Carles did not expressly disclose the upstream flow of information, including the claimed local traffic system schedule information. Instead, the Carles system dealt with one way, modifiable, distribution of transmitted video information for consumption. Carles specifically mentions that the head end servers in the system “perform substantially the same as distribution center (5) of Figure 1.” See, Column 8, Lines 57-59. Also, Carles specifically disclosed the use of regional head ends also sharing common functionality with these system elements. See, Column 8, Lines 59-62. Lastly, Carles specifically disclosed further levels of hierarchical management of signal distribution, local storage of content, and insertion of information at any level of the logical model. See, Column 9, Lines 1-15, and Column 9, Lines 31-32. An ordinary artisan working with the Carles system would have been motivated to explore the same art of head end content assembly and local information storage for distribution of specialized, customized content in order to find other head end embodiments for implementing the Carles invention.

17. In the same art of digital information assembly and distribution over a network including content insertion, Safadi specifically disclosed the provision for upstream flow of information to provide local scheduling information and local content referencing to effect modifying transmission flows. See, *inter alia*, Column 5, Lines 48-67, Column 7, Lines 28-38, and

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Column 8, Lines 15-34. Specifically, Safadi disclosed control signal receipt from a local scheduler in Column 8, Lines 25-28. Further inclusion of play lists, purge lists, content summary, etc., were all notoriously well known and widely implemented in the video distribution arts at the time of invention, and fail to provide a patentable distinction over the prior art of record.

18. The modification of the Carles video information distribution and content insertion system with the content insertion system of Safadi would have been obvious to one of ordinary skill in the art at the time of invention, minimally, since Carles specifically mentioned hierarchical implementation of content splicing functionality (Column 8, Lines 55-63) fully realized by the teachings of Safadi further providing uplink communication of content insertion (inter alia, Abstract).

19. Since the combination of Carles and Safadi and well known subject matter disclose all the claimed invention limitations, claims 1-20 are rejected.

20. Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Carles (U.S. Patent Number 5,515,098), hereinafter referred to as Carles, in view of Allan et al. (U.S. Patent Number 5,892,535), hereinafter referred to as Allan.

21. Carles disclosed a hierarchical arrangement of head end servers for video distribution of a wide area network. See, Column 8, Lines 54 through Column 9, Line 2, and Figure 5. The system utilized servers inserting content into prerecording programming transmission content. See, inter alia, Column 3, Lines 1-40. This stored content included real-time information, e.g., live broadcasts, etc. See, Column 3, Lines 12-13.

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22. While Carles disclosed the invention substantially as claimed, Carles did not expressly disclose the upstream flow of information, including the claimed local traffic system schedule information. Instead, the Carles system dealt with one way, modifiable, distribution of transmitted video information for consumption. Carles specifically mentions that the head end servers in the system “perform substantially the same as distribution center (5) of Figure 1.” See, Column 8, Lines 57-59. Also, Carles specifically disclosed the use of regional head ends also sharing common functionality with these system elements. See, Column 8, Lines 59-62. Lastly, Carles specifically disclosed further levels of hierarchical management of signal distribution, local storage of content, and insertion of information at any level of the logical model. See, Column 9, Lines 1-15, and Column 9, Lines 31-32. An ordinary artisan working with the Carles system would have been motivated to explore the same art of head end content assembly and local information storage for distribution of specialized, customized content in order to find other head end embodiments for implementing the Carles invention.

23. Allen clearly disclosed the use of a low level local media server (202) which functioned to mediate the passage information and traffic between the high level remote media server (central site) and the distribution network interface units (206) (at least one local traffic system). See, *inter alia*, Column 12, Line 31 through Column 13, Line 20, and Figure 2. Likewise, the remote (or any other) media server was also described as intermediate to off-site storage facilities and the distribution network interfaces in this section, particularly; Column 13, Lines 1-20. The provision for storage of information retrieved from external program sources for storage in the media servers (*inter alia*, Column 12, Lines 7-19), and the insertion of stored advertisements in the media servers for dissemination of combined programmatic information to end terminals in

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the distribution network (inter alia, Column 12, Lines 31-54), display bidirectional information flow between network elements, plainly evident from the Allan teachings in the entirety of the document, not only the above cited sections. Also, the routine rearrangement of functional elements within the system, including placement of the functional intermediate server(s) in various devices (i.e., the local and/or remote media servers) provided immense flexibility in implementation readily recognized by one of ordinary skill in the art at the time of invention, i.e., a video program operator or network administrator. In short, the media server(s) receive and store externally originating program data (inter alia, Column 11, Lines 1-5), "splice in" stored local data (inter alia, Column 9, Lines 43-52), and outputs specialized viewable program data (inter alia, Column 8, Line 62 through Column 9, Line 22), utilizing the media server(s) as intermediaries, precisely as claimed.

24. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the Carles system of video program and content assembly and distribution with the Allan teachings providing distributed storage of media information for subsequent assembly into transmission streams. See, Allan, inter alia, Column 10, Lines 18-42. Another clear advantage evident to typical engineers in this field includes basic enhancement of the digital distribution system (inter alia, Column 10, Lines 4-14), resulting in a "flexible and configurable system for distributing programming to one or more distribution networks by providing [an intermediate] media server". See, inter alia, Allan, Column 10, Lines 18-25. Allan further specifically disclosed bidirectional communication between the media server(s) and the distribution points, rendering the claims obvious over these combined teachings. Further inclusion of play lists, purge lists, content summary, etc., were all notoriously well known and widely implemented in

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the video distribution arts at the time of invention, and fail to provide a patentable distinction over the prior art of record.

25. Since the combination of Carles and Allan and well known subject matter disclose all the claimed invention limitations, claims 1-20 are rejected.

Response to Arguments

26. Applicant's arguments, filed 4/7/2005, with respect to prior bases of rejections have been fully considered and are persuasive. The finality of the rejections in this application has been withdrawn.

27. Applicant's arguments with respect to the pending claims are moot in view of the new ground(s) of rejection.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

29. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The Examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, William Cuchlinski, Jr. can be reached at 571-272-3925. The fax phone number for the organization where this application or proceeding is assigned remains 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 2144